

## **REMARKS**

### **Formal Matters**

Claims 1-2, 5-10, 12-13, 15-16 and 84-108 are pending after entry of the amendments set forth herein.

Claims 1-2, 5-10, 12-13, 15-16 and 84-108 were examined. Claims 1-2, 5-10, 12-13, 15-16 and 84-108 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

### **The Office Action**

#### **Claims Rejected On Ground of Non-Statutory Double Patenting (U.S. Patent No. 6,685,632)**

In the Official Action of May 9, 2008, claims 1-2, 5-10, 12-13, 15-16 and 101-108 were rejected on the ground of nonstatutory double patenting over claims 1-2, 5-10, 12-13 and 15-16 of U.S. Patent No. 6,685,632. The Examiner asserted that the claims if allowed would improperly extend the right to exclude already granted in the patent. The Examiner asserted that the claims in the patent are in effect a species of the generic invention recited in the present claims. Applicants respectfully traverse.

The Examiner asserted that, although the conflicting claims are not identical, the recitation of “at least one actuator” in claim 1 of the patent is considered to be equivalent to “a single actuator”. Applicants respectfully submit that “at least one actuator” includes two or more actuators, whereas “a single actuator” does not. Accordingly, it is respectfully submitted that the two recitations are not equivalent.

However, in order to render this ground of rejection moot, Applicants will submit a terminal disclaimer when all other non-double patenting type grounds of rejection have been removed.

However, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-2, 5-10, 12-13, 15-16 and 101-108 on the ground of nonstatutory double patenting over claims 1-2, 5-10, 12-13 and 15-16 of U.S. Patent No. 6,685,632, as being inappropriate.

**Claims Rejected On Ground of Nonstatutory Obviousness-Type Double Patenting (U.S. Patent No. 6,685,632 in view of Hancock)**

Claims 84-100 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,685,632 in view of Hancock, U.S. Patent No. 6,331,157. The Examiner asserted that the patented claims do not include a retractor with a drive mechanism and first and second retractor blades wherein the instrument is mountable to at least one of the blades. However, the Examiner asserted that it would have been obvious to provide the patented claims with the retractor shown by Hancock, in order to provide a stable support for the instrument mount and stabilizer. Applicants respectfully traverse.

Claim 84 also recites a single actuator that is actuatable to lock and unlock two joints included in the instrument mount assembly. Accordingly, it is respectfully submitted that claims 84-100 are allowable for at least the same reasons provided above with regard to the obviousness-type double patenting rejection of claim s1-2, 5-10, 12-13, 15-16 and 101-108.

Alternatively, in order to render this ground of rejection moot, Applicants will submit a terminal disclaimer when all other non-double patenting type grounds of rejection have been removed.

However, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 84-100 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,685,632 in view of Hancock, U.S. Patent No. 6,331,157. , as being inappropriate.

**Claims Rejected Under 35 U.S.C. Section 102(b) (Looney)**

Claims 1-2 were rejected under 35 U.S.C. Section 102(b) as being anticipated by Looney, U.S. Patent No. 5,876,332. The Examiner asserted that Looney discloses an instrument mount in Fig. 2 that includes a mount body 164 having a base portion movably coupled at a first articulating joint 20/105 and a side portion coupled at a second articulating joint 102/103 and a single actuator 108.

Applicants respectfully traverse. It is respectfully submitted that the components 102/103 of Looney, identified by the Examiner as a second articulating joint, do not movably couple a side portion. The Examiner did not identify a reference numeral for what she considers to be the “side portion”, as

claimed. Applicants respectfully submit that Fig. 2 of Looney does not include a side portion as claimed.

Further, claim 1 has been amended to recite that the first articulating joint provides three degrees of freedom of movement. It is respectfully submitted that joint 20/105 clearly does not provide three degrees of movement.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-2 under 35 U.S.C. Section 102(b) as being anticipated by Looney, U.S. Patent No. 5,876,332, as being inappropriate.

#### **Claims Rejected Under 35 U.S.C. Section 102(e) (Cartier et al.)**

Claims 101-106 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Cartier et al., U.S. Patent No. 6,102,854. The Examiner asserted that Cartier et al. shows an instrument mount apparatus (Figs. 3 and 5B) comprising a grip member 50 capable of being locked to and released from a stable support/rail 40 via flange 521; at least one joint member of ball 54/56 and socket 524 capable of movable connecting a surgical instrument 60 to the grip member 50; a single actuator 51 which can both lock the grip member 50 to the stable support/rail 40 and lock an orientation of the surgical instrument 60.

Applicants have amended claim 101 above to further recite a first joint member configured to allow movement, in an unlocked configuration, of an upper portion of said grip member relative to a lower portion of said grip member, said lower portion being configured to lock and release from said stable support. It is respectfully submitted that Cartier et al. clearly fails to disclose said first joint member as claimed.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 101-106 under 35 U.S.C. Section 102(e) as being anticipated by Cartier et al., U.S. Patent No. 6,102,854, as being inappropriate.

#### **Claims Rejected Under 35 U.S.C. Section 102(e) (Cartier et al.)**

Claims 84-89, 92-94 and 97-100 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Cartier et al., U.S. Patent No. 6,102,854. The Examiner asserted that Cartier et al. discloses a surgical system having a retractor 2/3/4 including a drive mechanism 2, two retractor blades

7 and an instrument mount assembly 50 slidably mounted on one of the blades along the rail 40.

Applicants have amended claim 84 above to further recite “one of said joints movably coupling a main body of said instrument mount assembly to a lower member of said instrument mount assembly that is fixable to a portion of at least one of said first and second retractor blades, and a second of said joints allowing movement between said surgical instrument and said main body when in said unlocked configuration. It is respectfully submitted that Cartier et al. clearly fails to disclose joints as now recited in claim 84.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 84-89, 92-94 and 97-100 under 35 U.S.C. Section 102(e) as being anticipated by Cartier et al., U.S. Patent No. 6,102,854, as being inappropriate.

**Claims Rejected Under 35 U.S.C. Section 103(a) (Cartier et al. in view of Benetti et al.)**

Claims 107-108 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cartier et al., U.S. Patent No. 6,102,854 in view of Benetti et al., U.S. Patent Application Publication No. 2001/0044572. The Examiner admitted that the stabilizer of Cartier et al. does not comprise a plurality of interconnecting links articulating with the joint member and the stabilizer, but asserted that it would have been obvious to replace the rod of Cartier et al. with the flexible system of Benetti et al. to enable the surgeon to place the stabilizer in many more orientations.

Applicants respectfully traverse. Claims 107-108 depend from claim 101, and, it is respectfully submitted, are therefore allowable for at least the same reasons provided above with regard to claim 101, since Benetti et al. does nothing to make up for the deficiencies of Cartier et al. in meeting the recitations of claim 101.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 107-108 under 35 U.S.C. Section 103(a) as being unpatentable over Cartier et al., U.S. Patent No. 6,102,854 in view of Benetti et al., U.S. Patent Application Publication No. 2001/0044572, as being inappropriate.

**Claims Rejected Under 35 U.S.C. Section 103(a) (Cartier et al. in view of Hancock)**

Claims 95-96 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Cartier et al., U.S. Patent No. 6,102,854 in view of Hancock, U.S. Patent No. 6,331,157. The Examiner admitted

that Cartier et al. lacks a disclosure of open slots on a retractor blade for receiving and securing sutures, but asserted that it would have been obvious to modify Cartier et al. to include suturing slots in order to receive and secure sutures therein.

Applicants respectfully traverse. Claims 95-96 depend from claim 84, and, it is respectfully submitted, are therefore allowable for at least the same reasons provided above with regard to claim 84, since Hancock does nothing to make up for the deficiencies of Cartier et al. in meeting the recitations of claim 84.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 95-96 under 35 U.S.C. Section 103(a) as being unpatentable over Cartier et al., U.S. Patent No. 6,102,854 in view of Hancock, U.S. Patent No. 6,331,157, as being inappropriate.

### Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-011CON2.

Respectfully submitted,  
LAW OFFICE OF ALAN W. CANNON

Date: \_\_\_\_\_

7/7/08

By: \_\_\_\_\_

  
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